UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,662	10/18/2001	Thiru Srinivasan	1585C (42059-01380)	4124

7590 01/29/2003

Marsh Fischmann & Breyfogle LLP
Suite 411
3151 S. Vaughn Way
Aurora, CO 80014

EXAMINER	
GRAVINI, STEPHEN MICHAEL	
ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/001,662	Thiru SRINIVASAN et al.
Examiner	**Art Unit**
Stephen M. Gravini	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 7-1-02

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideratio

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-21 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examine

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because the recitation "receive a the multimedia" is grammatically improper. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed method and system of buyer/seller mediation does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed detecting, employing, broadcasting, identifying, and transmitting contain recitations of descriptive material that cannot exhibit any functional interrelationship with the way in which computing process are performed and does not constitute a statutory process, machine, manufacture or composition of matter under 35 USC 101. Furthermore, each feature is not directed to statutory subject matter that falls within the technological arts such that the claimed invention is not required to have structural interaction with a machine. Each of the independently claimed features can be performed by a human without any structural or mechanical interaction (i.e. a person could detect a user, employ

identification information, broadcast multimedia information over a data network such as standing on a table at a network of friend gathering and performing a multimedia song and dance, detecting a commercial song and dance break, identify an appropriate commercial based on user mood, then orally or verbally transmit the appropriate commercial to the user during the song and dance break). Since the dependent claims are depending upon non-statutory subject matter, those claims are also rejected. Because the independently claimed invention is directed to non-functional descriptive material which does not produce a useful, concrete and tangible result, and the claimed invention does not require physical interaction with any type of structure, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The claimed features including:

detecting a commercial break during broadcasting of multimedia information;

based on the demographic information retrieved for at least one system user, identifying an appropriate commercial; and

transmitting the appropriate commercial to the at least one system user during the commercial break; along with

a second memory accessible by the server upon which is stored commercial which are transmittable to the at least one system user wherein the server is further configured to selected and transmit at least one appropriate commercial based on retrieved demographic information for at least one system user during at least one detected commercial break are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention because those steps are not described in the specification such that those skilled in the art would be reasonably conveyed that the inventor had possession of the inventive concept. Furthermore, the independently claimed "appropriate" feature is not enabling and is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. However in order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed features including:

detecting a commercial break during broadcasting of multimedia information;

based on the demographic information retrieved for at least one system user, identifying an appropriate commercial; and

transmitting the appropriate commercial to the at least one system user during the commercial break; along with

a second memory accessible by the server upon which is stored commercial which are transmittable to the at least one system user wherein the server is further configured to selected and transmit at least one appropriate commercial based on retrieved demographic information for at least one system user during at least one detected commercial break fail to particularly point out and distinctly claim the subject matter which applicant because that feature is indefinite from the accepted definitions to those skilled in the art and lacks an antecedent basis from the specification. Some of the claims are also rejected for introducing terms without a proper antecedent basis from within the claim or its depending claim. These terms include "the broadcast multimedia presentation" (claim 4), "the time available" (claim 6), "the connection" (claims 9 and

17), "the broadcast" (claim 10), "the memory" (claim 10), "the interactive component" (claim 10), "the connection" (claim 12), "the at least one memory" (claim 12), "the retrieved demographic information" (claim 12), "the Internet" (claim 13), "the plurality of system users" (claim 14), "the detected commercial breaks" (claim 16 wherein a singular break is earlier recited), "the at least one system server" (claim 18), "the appropriate commercials" (claim 19 wherein a singular commercial is earlier recited), "the commercials" (claims 20 and 21), and "the interactive element" (claim 21). Finally, the independently claimed "appropriate" feature is indefinite and fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. However in order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> a person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cogswell et al. (US 4,331,974), Wachob (US 5,155,591), Wilkins (US 5,446,919), Carles (US 5,515,098 or US 5,661,516), or Hendricks et al. (US 5,600,364), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Meyer et al. (WO 99/46708), Rangan et al. (US 6,006,265), Herz et al. (US 6,020,883), Miller et al. (WO 00/17775), or Eldering (US 6,298,348).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of NFL Super Bowl advertising information (hereinafter NFL) over a network Since at least 1990, NFL has performed the claimed method and system of broadcasting multimedia information over a data network comprising:

detecting at least one system user connected to receive multimedia information or a device connectable to the data network to which at least one system user may connect, wherein the device is configured to broadcast multimedia to the at least one system user over the data network;

employing identification information associated with the at least one system user to retrieve demographic information for the at least one system user or a first memory configured to store identification and demographic information for the at least one system user;

broadcasting the multimedia information over the data network to the at least one system user or said device is further configured to extract the identification information for the at least one system user upon establishment of the connection, which is then employed to search the at least one memory to locate demographic information; and

detecting a commercial break during broadcasting of the multimedia information and based on the demographic information retrieved for the at least one system user, identifying an appropriate commercial and transmitting the appropriate commercial to the at least one system user during the commercial break or a second memory accessible by the server upon which is stored commercials which are transmittable to the at least one system user wherein the server is further configured to select and transmit at least one appropriate commercial based on the retrieved demographic information for the at least one system user during the at least one detected commercial break. Examiner also has personal experience of the claimed method and system of broadcasting multimedia information over a data network including the features: different users,

live programming, monitoring and creating demographic information, ad hoc commercial breaks, time based and identification demographic analysis, database information retrieval and query of demographic information, interactive elements and plurality programming. Examiner considers the claimed data network to be equivalent to a television network, the claimed broadcasting multimedia information to be the television showing of the NFL, the claimed at least one system user to be an NFL viewer, and the claimed device to be a television. This examiner consideration of terms is used to reasonably interpret the claims in light of examiner's personal experience. The claimed detecting at least one system user connected to receive multimedia information or a device connectable to the data network to which at least one system user may connect, wherein the device is configured to broadcast multimedia to the at least one system user over the data network occurs when advertising agencies would purchase commercial breaks for the NFL. The claimed employing identification information associated with the at least one system user to retrieve demographic information for the at least one system user or a first memory configured to store identification and demographic information for the at least one system user occurs when the advertising agencies would target advertisements toward viewers of the Super Bowl for the NFL. The claimed broadcasting the multimedia information over the data network to the at least one system user or said device is further configured to extract the identification information for the at least one system user upon establishment of the connection, which is then employed to search the at least one memory to locate demographic information is merely the television station showing of the Super Bowl and NFL based on advertising agencies gathering data from common

demographic information gathering agencies such as Nielsen ratings or Gallop polls. The claimed detecting a commercial break during broadcasting of the multimedia information and based on the demographic information retrieved for the at least one system user, identifying an appropriate commercial and transmitting the appropriate commercial to the at least one system user during the commercial break or a second memory accessible by the server upon which is stored commercials which are transmittable to the at least one system user wherein the server is further configured to select and transmit at least one appropriate commercial based on the retrieved demographic information for the at least one system user during the at least one detected commercial break is merely how the advertising agencies and television stations work together to show Super Bowl advertisements. The claimed invention, recited by the applicant, has been provided by NFL long before the filing of applicants' invention except for the claimed server, Internet, and IP address or login ID. The claimed features including different users, live programming, monitoring and creating demographic information, ad hoc commercial breaks, time based and identification demographic analysis, database information retrieval and query of demographic information, interactive elements and plurality programming are so old and well known to those who have ever viewed television as a member or a targeted marketing demographic group have performed the claimed invention such that the examiner will use Official notice to obviate that claimed subject matter. Examiner notes that it is old and well known to those skilled in the art of providing advertising information over a network, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal

experience discussed supra. It would have been obvious to one skilled in the art to the claimed server, Internet, and IP address or login ID since those features are merely an automated feature of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. Applicants admit that monitoring demographic information using Nielsen or Arbitron ratings for television and radio multimedia information broadcasting is old and well known as discussed in the background of the invention of the specification. The motivation to combine applicants claimed invention with the examiner's personal experience of NFL is to allow advertisers greater targeting capabilities, while transferring information more efficiently, which clearly shows the obviousness of the claimed invention.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. a terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over applicants' earlier patent US 6,411,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application claims a broader obvious variation of the patented claimed invention without the narrower features including creating a programming schedule and identifying commercial breaks (this feature is not claimed in the present application). Both the present application and the patented invention perform the same function in the same manner with the same result but using different obviousness terminology.

Conclusion

15. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	**(703) 872-9327**
Official	**(703) 872-9326**
Non-Official/Draft	**(703) 872-9325**

Steve Gravini

STEPHEN GRAVINI

PRIMARY EXAMINER

smg

January 23, 2003